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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125615
Party	Plaintiff UNIVERSITY OF SOUTHERN CALIFORNIA ,
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Submission	Plaintiff's Notice of Reliance
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Date	05/10/2006
Attachments	Opp NOR 25.pdf (7 pages)(204918 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 91125615

Serial No. 75/358,031

Mark: **SC (Stylized)**

Filed: September 16, 1997

Published: May 18, 1999

**OPPOSER'S NOTICE OF RELIANCE NO. 25
ON STATEMENTS IN PLEADINGS**

Opposer the University of Southern California ("Opposer" or "California") hereby introduces into evidence by this Notice of Reliance an excerpt from a pleading filed in this action by the University of South Carolina ("Applicant" or Carolina). This excerpt, attached as Opposer's Exhibit 419, is taken from Applicant and Petitioner's Response to Motion to Dismiss, dated December 12, 2002, and filed with the Board in this action on December 17, 2005.

Opposer submits this except to demonstrate that Carolina stated in pleadings filed with the Board that it does not object to the stylized form of Opposer's SC mark.

This Notice of Reliance is submitted pursuant to TBMP § 704.06(a) as a statement in a pleading that constitutes an admission against interest by Carolina, and pursuant to TBMP § 704.07 as an official record.

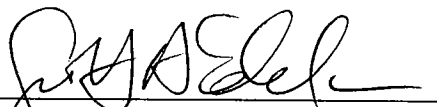
As stated in TBMP § 704.06(a), "statements in pleadings may have evidentiary value as admissions against interest by the party that made them."

As the pages attached as Opposer's Exhibit 419 are taken from a pleading previously filed with the Board in this action, and the contents are not reasonably subject to dispute and are moreover capable of immediate and accurate determination, the requirements of 37 C.F.R. § 2.122(e) and TBMP § 704.07 are satisfied.

Dated: May/10, 2006

Respectfully submitted,

GIBSON, DUNN & CRUTCHER, LLP

A handwritten signature in black ink, appearing to read "SA Edelman", written over a horizontal line.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California)	Opposition No.: 125,615
Opposer,)	
)	Serial No.: 75/358,031
vs.)	
)	Mark: "SC" (Stylized)
University of South Carolina,)	
Applicant.)	
University of South Carolina)	Opposition No.: 125,615
Petitioner,)	
)	Reg. No.: 1,844,953
vs.)	
)	Mark: SC Word Mark
University of Southern California)	
Registrant.)	

APPLICANT AND PETITIONER'S RESPONSE TO MOTION TO DISMISS

I. INTRODUCTION

The University of Southern California's ("Registrant" or "California") motion to dismiss is another misguided effort in its overly aggressive attempt to limit the trademark rights of the State of South Carolina, through its agency, the University of South Carolina ("Petitioner" or "South Carolina"). California is simply incorrect in its assertion that this matter arises out of recent use by South Carolina of the letters "SC" in connection with its athletic programs. To the contrary, as alleged in its Answer and Counterclaim, the University of South Carolina has used this mark since at least as early as 1898, which is prior to California's use. Instead, this case arose when California filed an opposition proceeding

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Ex. No. 419, Pg. No. 1

and unmistakably point to the State of South Carolina. In other words, a decision on the merits will hinge upon the strength of affiliation of the "SC" mark with the State of South Carolina. There could not be a clearer example of a purely factual dispute. Further, none of the cases cited by California allow such a determination to be made as a matter of law on a motion to dismiss. See e.g. In re Nuclear Research Corp., 16 U.S.P.Q.2d 1316 (T.T.A.B. 1990) (Decision rendered after ex parte appeal briefing); Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 438 (T.T.A.B. 1985) (Decision rendered on motion for summary judgment); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 703 F.2d 1372 (Fed. Cir. 1983) (Decision rendered after trial).

California baldly argues, as a matter of law, that since there are other registrations of marks containing the letters "SC" they cannot uniquely identify the government of South Carolina. However, as discussed by the Board in In re Horwitt, all this establishes is that the letters "SC" are not "per se precluded by Section 2(a)." 125 U.S.P.Q. 145 (T.T.A.B. 1960) (Applicant submitted more than ninety registration issued to other marks consisting of the letters "U.S."). Thus, the existence of other registrations does not, as a matter of law, preclude South Carolina's claim that the letters "SC" may point uniquely to it. California has not and cannot cite any case law to the contrary.

Moreover, as discussed above, use of this evidence is improper. However, if considered, most, if not all, of these registrations are for stylized versions of the letters "SC", which South Carolina does not claim falsely suggest a connection to it. On the other hand, California has claimed in its opposition proceeding that its use of the word mark, or the letters "SC" in U.S. Reg. 1,844,953 is likely to be confused with South Carolina's use of the letters

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"SC." This supports the position that California's registration of the word mark letters "SC" suggests a connection between the two entities.²

As recited in its pleadings, the State of South Carolina has a long history of use of the letters "SC" throughout its past. Since 1775, South Carolina has adopted "SC" for use in various capacities. Incredibly, California suggests in its brief that the letters "SC" do not suggest an affiliation with South Carolina. (Motion to Dismiss, p. 12). Considering only the wide use of state abbreviations, this is an absurd argument. This is especially true in the case of "two-word state names" where, in every instance, the letters used for the common abbreviation are the first letters of each word (SC-South Carolina; NC-North Carolina; RI-Rhode Island; NH-New Hampshire; NY-New York; NJ-New Jersey; ND-North Dakota; SD-South Dakota). Based solely on the use of "SC" as an abbreviation, the mark standing alone has a unique and primary association with South Carolina.

California has attempted to mischaracterize South Carolina's argument by stating that it would require the cancellation of numerous marks. At this point, it must be stated that South Carolina does not intend for any marks, other than the one fraudulently procured by California, to be cancelled. None of the other possessors of marks including the letters "SC" have attempted to preclude either South Carolina from using the letters "SC." As a result, any unfounded leaps in logic attempted by California in the present matter relating to the cancellation of marks outside of this proceeding are both irrelevant and inflammatory.

² Here, South Carolina only challenges California's word mark registration of the letters "SC", which it has sought to prevent the State of South Carolina from using. South Carolina does not take the position that other stylized uses of the letters "SC" falsely suggest a connection to it. Likewise, South Carolina does not take the position that there is a likelihood of confusion between its use of the stylized letters "SC" and California's marks.

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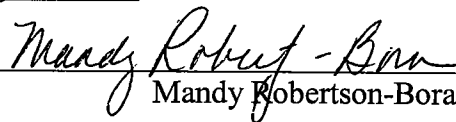
CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S NOTICE OF RELIANCE NO. 25 ON STATEMENTS IN PLEADINGS** is being placed in the United States mail, first class, postage pre-paid, on May 10, 2006, addressed to the following:

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Charleston, SC
29401-2239

Attorneys for Applicant University of South Carolina

A copy is being sent by e-mail to JCM@nmrs.com on the same date.


Mandy Robertson-Bora